

phenyl or naphthyl mono-, di- or trisubstituted, the substituent "halogen" has now been omitted).

The Examiner has objected to claims 2-9 as being of improper dependent form for failing to further limit the subject matter of a previous claim; specifically, claim 1 recites that the required element of an  $\alpha$ -amino acid cannot be glycine, and claims 2-9 are drawn to an alpha-amino acid that can be glycine. For similar reasons, the claims have been rejected under 35 U.S.C. § 112. While Applicants agree that dependent claims 2-9 are drawn to an  $\alpha$ -amino acid that *can* be glycine, these claims carry with them the same limitations of claim 1, i.e. that the  $\alpha$ -amino acid cannot be glycine only when *R<sub>2</sub> is a phenyl or naphthyl group which is mono-, di- or tri-substituted with a halogen atom*. In all other instances, the  $\alpha$ -amino acid can be glycine, and claims 2-9 are consistent in this respect. For this reason, withdrawal of the objection and the § 112 rejection is respectfully requested.

The Examiner has rejected claims 1-8 as being anticipated by Robson. Robson teaches a composition comprising baclofen and glycine. As stated above, the instant claims require that when *R<sub>2</sub>* is a phenyl or naphthyl group which is mono-, di- or tri-substituted with a halogen atom, the  $\alpha$ -amino acid is not glycine. Baclofen is a 4-amino-3-substituted-butanoic acid in which *R<sub>2</sub>* is 4-chlorophenyl and *R<sub>1</sub>* is hydrogen. Therefore, the cited reference does not anticipate the pharmaceutical preparation of the instant claims.

Claim 1 has been amended such that when the 4-amino-3-substituted-butanoic acid derivative is gabapentin and the  $\alpha$ -amino acid is a methyl-aspartic acid, the methyl aspartic acid is not methyl-D-aspartic acid. A marked-up copy of claim 1 is included

herewith. No new matter is added with this amendment. Woodruff teaches a solution comprising N-methyl-D-aspartic acid and gabapentin. As such, the instant claims are not anticipated by the Woodruff reference.

Allowance of the claims and passage of the case to issue are respectfully solicited. The Applicants urge the Examiner to contact the Applicants' undersigned representative at (312) 913-0001 if he believes that this would expedite prosecution of this application.

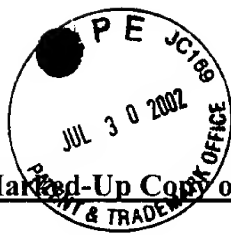
Respectfully submitted,

By: 

Dated: July 30, 2002

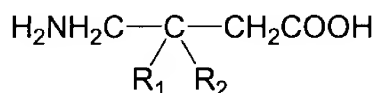
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Marked-Up Copy of Claims for U.S.S.N. 09/674,815

1. (Twice Amended) A stabilized pharmaceutical preparation, comprising: (a) an  $\alpha$  amino acid; (b) an optional auxiliary agent for manufacturing a pharmaceutical preparation; and (c) a 4-amino-3-substituted-butanoic acid derivative, which 4-amino-3-substituted-butanoic acid derivative has the general formula:



wherein,

$\text{R}_1$  is a hydrogen atom, a hydroxyl group, a methyl group or an ethyl group;

$\text{R}_2$  is a monovalent group selected from:

a straight or branched alkyl group of 3 - 8 carbon atoms;

a straight or branched alkylene group of 3 - 8 carbon atoms;

a straight or branched alkyl group of 3 - 8 carbon atoms which is mono- or di-substituted with a halogen atom, a trifluoromethyl group, a hydroxyl group, an alkoxy group, an alkylthio group, an amino group, a nitro group, an oxo group, a carboxyl group or a carboalkoxy group;

a cycloalkyl group of 3 - 8 carbon atoms;

a cycloalkyl group of 3 - 8 carbon atoms which is mono-, di- or tri-substituted with a halogen atom, a trifluoromethyl group, a hydroxyl group, an alkyl group, an alkoxy group, an alkylthio group, an amino

group, a nitro group, an oxo group, a carboxyl group or a carboalkoxy group;

a condensed ring group formed by ortho-fusion of a phenyl ring with a cycloalkyl group of 4 - 8 carbon atoms;

a condensed ring group formed by ortho-fusion of a phenyl ring with a cycloalkyl group of 4 - 8 carbon atoms wherein said phenyl ring is mono-, di- or tri-substituted with a halogen atom, a trifluoromethyl group, a hydroxyl group, an alkyl group, an alkoxy group, an alkylthio group, an amino group, a nitro group, a carboxyl group or a carboalkoxy group;

a condensed ring group formed by ortho-fusion of a phenyl ring with a cycloalkenyl group of 5 - 8 carbon atoms or a cycloalkanedieryl group of 5 - 8 carbon atoms;

a condensed ring group formed by ortho-fusion of a phenyl ring with a cycloalkenyl group of 5 - 8 carbon atoms or a cycloalkanedieryl group of 5 - 8 carbon atoms wherein said phenyl ring is mono-, di- or tri-substituted with a halogen atom, a trifluoromethyl group, a hydroxyl group, an alkyl group, an alkoxy group, an alkylthio group, an amino group, a nitro group, a carboxyl group or a carboalkoxy group;

an alkylcycloalkyl group wherein said cycloalkyl has 3 - 8 carbon atoms and is linked to an alkylene group having 1 - 4 carbon atoms optionally interrupted with -O-, -S- or -SS-;

an alkylcycloalkyl group wherein said cycloalkyl has 3 - 8 carbon atoms, is linked to an alkylene group having 1 - 4 carbon atoms optionally

interrupted with -O-, -S- or -SS- and is mono-, di- or tri-substituted with a halogen atom, a trifluoromethyl group, a hydroxyl group, an alkyl group, an alkoxy group, an alkylthio group, an amino group, a nitro group, an oxo group, a carboxyl group or a carboalkoxy group;

a cycloalkyl group of 5 - 8 carbon atoms wherein one of the methylene groups (-CH<sub>2</sub>-) is replaced by -O-, -NH-, -S-, -SO- or -S(O)<sub>2</sub>-;

a cycloalkyl group of 5 - 8 carbon atoms wherein one of the methylene groups (-CH<sub>2</sub>-) is replaced by -O-, -NH-, -S-, -SO- or -S(O)<sub>2</sub>-, and one or two of the unsubstituted methylene groups (-CH<sub>2</sub>-) are mono- or di-substituted with a halogen atom, a trifluoromethyl group, a hydroxyl group, an alkyl group, an alkoxy group, an alkylthio group, an amino group, a nitro group, an oxo group, a carboxyl group or a carboalkoxy group;

a cycloalkenyl group of 5 - 8 carbon atoms or a cycloalkanedienyl group of 5 - 8 carbon atoms, one of the methylene groups (-CH<sub>2</sub>-) in said cycloalkenyl ring or cycloalkanedienyl ring being replaced by -O-, -NH-, =N-, -S-, -SO- or -S(O)<sub>2</sub>-;

a cycloalkenyl group of 5 - 8 carbon atoms or a cycloalkanedienyl group of 5 - 8 carbon atoms, one of the methylene groups (-CH<sub>2</sub>-) in said cycloalkenyl ring or cycloalkanedienyl ring being replaced by -O-, -NH-, =N-, -S-, -SO- or -S(O)<sub>2</sub>-, and one or two of the unsubstituted methylene groups (-CH<sub>2</sub>-) being mono- or di-substituted with a halogen atom, a trifluoromethyl group, a hydroxyl group, an alkyl group, an alkoxy group,

an alkylthio group, an amino group, a nitro group, an oxo group, a carboxyl group or a carboalkoxy group;

a condensed ring group formed by ortho-fusion of a phenyl ring with a cycloalkyl group of 5 - 8 carbon atoms wherein one of the methylene groups (-CH<sub>2</sub>-) is replaced by -O-, -NH-, -S-, -SO- or -S(O)<sub>2</sub>-;

a condensed ring group formed by ortho-fusion of a phenyl ring with a cycloalkyl group of 5 - 8 carbon atoms wherein one of the methylene groups (-CH<sub>2</sub>-) is replaced by -O-, -NH-, -S-, -SO- or -S(O)<sub>2</sub>-, said phenyl group being mono- or di-substituted with a halogen atom, a trifluoromethyl group, a hydroxyl group, an alkyl group, an alkoxy group, an alkylthio group, an amino group, a nitro group, a carboxyl group or a carboalkoxy group;

a condensed ring group formed by ortho-fusion of a phenyl ring with a cycloalkenyl group of 5 - 8 carbon atoms or a cycloalkanedieryl group of 5 - 8 carbon atoms, one of the methylene groups (-CH<sub>2</sub>-) in said cycloalkenyl ring or cycloalkanedieryl ring being replaced by -O-, -NH-, =N-, -S-, -SO- or -S(O)<sub>2</sub>-;

a condensed ring group formed by ortho-fusion of a phenyl ring with a cycloalkenyl group of 5 - 8 carbon atoms or a cycloalkanedieryl group of 5 - 8 carbon atoms, one of the methylene groups (-CH<sub>2</sub>-) in said cycloalkenyl ring or cycloalkanedieryl ring being replaced by -O-, -NH-, =N-, -S-, -SO- or -S(O)<sub>2</sub>-, said phenyl ring being mono- or di-substituted with a halogen atom, a trifluoromethyl group, a hydroxyl group, an alkyl

group, an alkoxy group, an alkylthio group, an amino group, a nitro group, a carboxyl group or a carboalkoxy group;

an alkylcycloalkyl group wherein said cycloalkyl has 5 - 8 carbon atoms and is linked to an alkylene group having 1 - 4 carbon atoms optionally interrupted with -O-, -S- or -SS-, one of the methylene groups (-CH<sub>2</sub>-) in said cycloalkyl ring being replaced by -O-, -NH-, -S-, -SO- or -S(O)<sub>2</sub>-;

an alkylcycloalkyl group wherein said cycloalkyl has 5 - 8 carbon atoms and is linked to an alkylene group having 1 - 4 carbon atoms optionally interrupted with -O-, -S- or -SS-, and one of the methylene groups (-CH<sub>2</sub>-) in said cycloalkyl ring being replaced by -O-, -NH-, -S-, -SO- or -S(O)<sub>2</sub>- and one or two of the unsubstituted methylene groups (-CH<sub>2</sub>-) being mono-, di- or tri-substituted with a halogen atom, a trifluoromethyl group, a hydroxyl group, an alkyl group, an alkoxy group, an alkylthio group, an amino group, a nitro group, an oxo group, a carboxyl group or a carboalkoxy group;

a phenyl or naphthyl group;

a phenyl group substituted with a methylenedioxy group;

a phenyl or naphthyl group which is mono-, di- or tri-substituted with a halogen atom, a trifluoromethyl group, a hydroxyl group, an alkyl group, an alkoxy group, an amino group, a nitro group, a carboxyl group, a phenoxy group, a phenylmethoxy group, a phenylmethoxy group wherein said phenyl ring is mono-substituted with a halogen atom, trifluoromethyl

group, an alkoxy group, an amino group, a nitro group, a carboxyl group or a carboalkoxy group, a cycloalkylmethoxy group having 5 - 8 carbon atoms in the cycloalkyl ring, a cycloalkenylmethoxy group having 5 - 8 carbon atoms in the cycloalkenyl ring, a cycloalkanedienylmethoxy group having 5 - 8 carbon atoms in the cycloalkanedienyl ring, a cycloalkylmethoxy group wherein one of the methylene groups (-CH<sub>2</sub>-) in said cycloalkyl ring having 5 - 8 carbon atoms is replaced by -O-, -NH-, -S-, -SO- or -S(O)<sub>2</sub>-, a cycloalkenylmethoxy group wherein one of the methylene groups (-CH<sub>2</sub>-) in said cycloalkenyl ring having 5 - 8 carbon atoms is replaced by -O-, -NH-, =N-, -S-, -SO- or -S(O)<sub>2</sub>-, a cycloalkanedienyl-methoxy group wherein one of the methylene groups (-CH<sub>2</sub>-) in said cycloalkanedienyl ring having 5 - 8 carbon atoms is replaced by -O-, -NH-, =N-, -S-, -SO- or -S(O)<sub>2</sub>- group, a cycloalkylmethoxy group having 5 - 8 carbon atoms in the cycloalkyl ring wherein said cycloalkyl ring is mono-substituted with a halogen atom, trifluoromethyl group, a hydroxy group, an alkyl group, an alkoxy group, an amino group, a nitro group, a carboxyl group or a carboalkoxy group and one of the methylene groups (-CH<sub>2</sub>-) in said cycloalkyl ring is replaced by -O-, -NH-, -S-, -SO- or -S(O)<sub>2</sub>-, a cycloalkenylmethoxy group having 5 - 8 carbon atoms in the cycloalkenyl ring wherein said cycloalkenyl ring is mono-substituted with a halogen atom, a trifluoromethyl group, a hydroxy group, an alkyl group, an alkoxy group, an amino group, a nitro group, an oxo group, a carboxyl group or a



carboalkoxy group and one of the methylene groups (-CH<sub>2</sub>-) in said cycloalkenyl ring is replaced by -O-, -NH-, =N-, -S-, -SO- or -S(O)<sub>2</sub>-, or a cycloalkanediénylmethoxy group having 5 - 8 carbon atoms in the cycloalkanediényl ring wherein said cycloalkanediényl ring is mono-substituted with a halogen atom, a trifluoromethyl group, a hydroxyl group, an alkyl group, an alkoxy group, an amino group, a nitro group, an oxo group, a carboxyl group or a carboalkoxy group and one of the methylene groups (-CH<sub>2</sub>-) in said cycloalkanediényl ring is replaced by -O-, -NH-, =N-, -S-, -SO- or -S(O)<sub>2</sub>-;

an alkylphenyl group wherein said phenyl group is linked to an alkylene group having 1 - 4 carbon atoms optionally interrupted with -O-, -S- or -SS-;

an alkyl-O-, -S- or -SS-phenyl group wherein said phenyl group is linked to an alkylene group having 1 - 4 carbon atoms via -O-, -S- or -SS-;

an -O-, -S- or -SS-phenyl group;

a diphenylamino group;

an alkylphenyl group wherein said phenyl group is linked to an alkylene group having 1 - 4 carbon atoms optionally interrupted with -O-, -S- or -SS- and mono-, di- or tri-substituted with a halogen atom, a trifluoromethyl group, a hydroxyl group, a alkyl group, an alkoxy group, an amino group, a nitro group or a carboxyl group;

an alkyl-O-, -S- or -SS-phenyl group wherein said phenyl group is linked to an alkylene group having 1 - 4 carbon atoms via -O-, -S- or -SS-

and mono-, di- or tri-substituted with a halogen atom, a trifluoromethyl group, a hydroxyl group, an alkyl group, an alkoxy group, an amino group, a nitro group or a carboxyl group;

an -O-, -S- or -SS-phenyl group wherein said phenyl group is mono-, di- or tri-substituted with a halogen atom, a trifluoromethyl group, a hydroxyl group, an alkyl group, an alkoxy group, an amino group, a nitro group or a carboxyl group;

or

R<sub>1</sub> and R<sub>2</sub>, together with the carbon atom to which they are attached, may form a divalent group selected from:

a cycloalkylidene group of 5 - 8 carbon atoms;

a cycloalkylidene group of 5 - 8 carbon atoms which is mono-, di-, tri- or tetra-substituted with a halogen atom, a trifluoromethyl group, a hydroxyl group, an alkyl group, an alkoxy group, an alkylthio group, a cycloalkyl group, a phenyl group, an amino group, a nitro group or a carboxyl group;

a cycloalkylidene group of 5 - 8 carbon atoms wherein one of the methylene groups (-CH<sub>2</sub>-) in said cycloalkyl ring is replaced by -O-, -NH-, -S-, -SO- or -S(O)<sub>2</sub>-;

a cycloalkylidene group of 5 - 8 carbon atoms wherein one of the methylene groups (-CH<sub>2</sub>-) in said cycloalkyl ring is replaced by -O-, -NH-, -S-, -SO- or -S(O)<sub>2</sub>- group and one or more of the unsubstituted methylene groups (-CH<sub>2</sub>-) in said cycloalkyl ring are mono-, di-, tri- or

tetra-substituted with a halogen atom, a trifluoromethyl group, a hydroxyl group, an alkyl group, an alkoxy group, an alkylthio group, an amino group, a nitro group, an oxo group, a carboxyl group or a carboalkoxy group;

a cycloalkenylidene group of 5 - 8 carbon atoms or a cycloalkanedierylidene group of 5 - 8 carbon atoms;

a cycloalkenylidene group of 5 - 8 carbon atoms or a cycloalkanedierylidene group of 5 - 8 carbon atoms which is mono-, di-, tri- or tetra-substituted with a halogen atom, a trifluoromethyl group, a hydroxyl group, an alkyl group, an alkoxy group, an alkylthio group, a cycloalkyl group, a phenyl group, an amino group, a nitro group, an oxo group, a carboxyl group or a carboalkoxy group;

a cycloalkenylidene group of 5 - 8 carbon atoms or a cycloalkanedierylidene group of 5 - 8 carbon atoms wherein one of the methylene groups (-CH<sub>2</sub>-) in said cycloalkenyl ring or cycloalkanedieryl ring is replaced by -O-, -NH-, =N-, -S-, -SO- or -S(O)<sub>2</sub>-;

a cycloalkenylidene group of 5 - 8 carbon atoms or a cycloalkanedierylidene group of 5 - 8 carbon atoms wherein one of the methylene groups (-CH<sub>2</sub>-) in said cycloalkenyl ring or cycloalkanedieryl ring is replaced by -O-, -NH-, =N-, -S-, -SO- or -S(O)<sub>2</sub>- group and one or more of the unsubstituted methylene groups (-CH<sub>2</sub>-) in said cycloalkenyl ring or cycloalkanedieryl ring are mono-, di-, tri- or tetra-substituted with a halogen atom, a trifluoromethyl group, a hydroxyl group, an alkyl group,

an alkoxy group, an alkylthio group, an amino group, a nitro group, an oxo group, a carboxyl group or a carboalkoxy group;

a condensed ring group formed by ortho-fusion of a phenyl ring with a cycloalkylidene group of 4 - 8 carbon atoms;

a condensed ring group formed by ortho-fusion of a phenyl ring with a cycloalkylidene group of 4 - 8 carbon atoms, said phenyl ring being mono-, di-, tri- or tetra-substituted with a halogen atom, a trifluoromethyl group, a hydroxyl group, an alkyl group, an alkoxy group, an alkylthio group, an amino group, a nitro group, a carboxyl group or a carboalkoxy group;

a condensed ring group formed by ortho-fusion of a phenyl ring with a cycloalkenylidene group of 5 - 8 carbon atoms or a cycloalkanedienylidene group of 5 - 8 carbon atoms;

a condensed ring group formed by ortho-fusion of a phenyl ring with a cycloalkenylidene group of 5 - 8 carbon atoms or a cycloalkanedienylidene group of 5 - 8 carbon atoms, said phenyl ring being mono- or di-substituted with a halogen atom, a trifluoromethyl group, a hydroxyl group, an alkyl group, an alkoxy group, an alkylthio group, an amino group, a nitro group, a carboxyl group or a carboalkoxy group; or

provided that when R<sub>2</sub> is a phenyl or naphthyl group which is mono-, di- or tri-substituted with a halogen atom, the  $\alpha$ -amino acid is not glycine; and

provided that when the 4-amino-3-substituted-butanoic acid derivative is gabapentin and the  $\alpha$ -amino acid is a methyl-aspartic acid, the methyl aspartic acid is not methyl-D-aspartic acid.